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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ROSEN, N

ART UNIT

PAPER NUMBER

2165

DATE MAILED:

10/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/290,251

Applicant(s)
Nagai et al.

Examiner
Nicholas Rosen

Art Unit
2165



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 22, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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1. Claims 1-16 have been examined.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).
4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz in view of Doi. Linnartz discloses a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying permission on a signal of digitized video data and/or a signal of audio data or embedding the information therein (Abstract; see also column 2, line 26, through

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column 3, line 67), said reproduction apparatus comprising: a reproducing unit which reproduces the information concerning copying permission superimposed on or embedded in the video data and/or audio data (Abstract; column 5, lines 41-54); and a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 6, lines 22-45). Linnartz discloses a determining unit which determines whether the medium to be reproduced is a recordable medium (column 5, lines 54-66; column 7, lines 4-13), but does not clearly and expressly disclose determining whether the medium to be reproduced is dedicated to reproduction or to recording; however, Doi teaches determining whether a medium is dedicated to reproduction or recording (column 13, lines 46-55). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include in the apparatus disclosed by Linnartz a determining unit which determines whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, according to Doi, and to stop reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz in view of Doi, Tozaki et al., and Mardirossian. Linnartz discloses a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data

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being generated by superimposing information concerning copying permission on a signal of digitized video data and/or a signal of audio data or embedding the information therein (Abstract; see also column 2, line 26, through column 3, line 67), said reproduction apparatus comprising: a reproducing unit which reproduces the information concerning copying permission superimposed on or embedded in the video data and/or audio data (Abstract; column 5, lines 41-54); and a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 6, lines 22-45). Linnartz discloses a determining unit which determines whether the medium to be reproduced is a recordable medium (column 5, lines 54-66; column 7, lines 4-13), but does not clearly and expressly disclose determining whether the medium to be reproduced is dedicated to reproduction or to recording; furthermore, Doi teaches determining whether a medium is dedicated to reproduction or recording (column 13, lines 46-55). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include in the apparatus of Linnartz a determining unit which determines whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, according to Doi, and to stop reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

a. Linnartz does not disclose an error correction unit, but Tozaki et al. teach an error correction unit which conducts error correction according to an added correction code (column

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14, lines 46-51; note also column 13, lines 51-57). Hence it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include in the apparatus of Linnartz an error correction unit, for the stated advantage of correcting errors.

b.Linnartz does not disclose a destroying unit which destroys reproduced data so as to make the video data and/or audio data non-reproducible in response to information indicating that copying once was permitted and a result of the determining unit indicating that the medium is a medium dedicated to reproduction. However, Mardirossian (5,636,096) teaches destroying data to prevent unauthorized copying (Abstract; column 5, lines 12-35). (See also, for example, Park, 5,796,826, Abstract; and column 5, lines 49-57.) Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include in the apparatus of Linnartz a destroying unit which destroys reproduced data so as to make the video data and/or audio data non-reproducible in response to the information reproduced by a reproducing unit indicating that copying once was permitted and a result of the determining by the determining unit indicating that the medium is a medium dedicated to reproduction, for the obvious advantages of preventing unauthorized reproduction and deterring attempts thereat.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz in view of Doi, Tozaki et al. and Mardirossian. Claim 3 largely recites the same limitations as claim 2, and is therefore rejected on the same grounds. Claim 3 additionally recites that the destroying unit destroys data so as to make error detection of data not yet subjected to error correction processing possible and make error correction thereof impossible to certain indications. Neither Linnartz

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nor Tozaki et al. expressly disclose these limitations. However, when data is destroyed, error correction thereof becomes impossible; when data is not destroyed, error detection and correction by well-known techniques, as disclosed in Tozaki et al., may remain possible. Hence, the apparatus of claim 3 is held not to differ substantially from that of claim 2.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz in view of Doi. Linnartz discloses a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying permission on a signal of digitized video data and/or a signal of audio data (Abstract; see also column 2, line 26, through column 3, line 67), said reproduction apparatus comprising: a reproduction unit which reproduces the information concerning copying permission superimposed on the video data and/or audio data (Abstract; column 5, lines 41-54); and an identifying unit which determines whether the medium to be reproduced is a recordable medium (column 5, lines 54-66; column 7, lines 4-13), but does not clearly and expressly disclose determining whether the medium to be reproduced is dedicated to reproduction or to recording; furthermore, Doi teaches determining whether a medium is dedicated to reproduction or recording (column 13, lines 46-55). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include in the apparatus of Linnartz a determining unit which determines whether a medium to be reproduced is a

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medium dedicated to reproduction or a recordable medium, and to stop reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

a. Linnartz discloses a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted and a result of the identification by the identifying unit indicating that the medium is a medium dedicated to reproduction (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 5, lines 54-66; column 6, lines 22-45).

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz in view of Doi, Tozaki et al., and Mardirossian. Linnartz discloses a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying permission on a signal of digitized video data and/or a signal of audio data (Abstract; see also column 2, line 26, through column 3, line 67), said reproduction apparatus comprising: a reproducing unit which reproduces the information concerning copying permission superimposed on the video data and/or audio data (Abstract; column 5, lines 41-54); and an identifying unit which identifies whether the medium to be reproduced is a recordable medium (column 5, lines 54-66; column 7, lines 4-13), but does not clearly and expressly disclose determining whether the medium to be reproduced is

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dedicated to reproduction or to recording; furthermore, Doi teaches determining whether a medium is dedicated to reproduction or recording (column 13, lines 46-55). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include in the apparatus of Linnartz a determining unit which determines whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, in accordance with Doi, and to stop reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

a.Linnartz does not disclose an error correction unit, but Tozaki et al. teach an error correction unit which conducts error correction according to an added correction code (column 14, lines 46-51; note also column 13, lines 51-57). Hence it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include an error correction unit, for the stated advantage of correcting errors.

b.Linnartz discloses a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted and a result of the identification by the identifying unit indicating that the medium is a medium dedicated to reproduction (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 5, lines 54-66; column 6, lines 22-45). Linnartz does not disclose a destroying unit which destroys reproduced data so as to make the video data and/or audio data non-reproducible in response to information indicating that copying once was permitted and a result of the

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determining unit indicating that the medium is a medium dedicated to reproduction. However, Mardirossian (5,636,096) teaches destroying data to prevent unauthorized copying (Abstract; column 5, lines 12-35). (See also, for example, Park, 5,796,826, Abstract; and column 5, lines 49-57.) Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a destroying unit which destroys reproduced data so as to make the video data and/or audio data non-reproducible in response to the information reproduced by a reproducing unit indicating that copying once was permitted and a result of the determining by the determining unit indicating that the medium is a medium dedicated to reproduction, for the obvious advantages of preventing unauthorized reproduction and deterring attempts thereat.

c.Linnartz does not disclose an output unit which outputs video data and/or audio data representing a reason why reproduction is not possible. However, official notice is taken that it is well known for computers and other apparatuses to output data representing a reason why operations are not possible, and that it is well known to convey information by video data (e.g., written words on a screen, diagrams, and other symbols) and by audio (e.g., spoken, recorded, or generated words, as well as buzzer sounds, etc.). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to output video data and/or audio data representing a reason why reproduction was not possible, for the obvious advantage of conveniently notifying users, and encouraging them to buy copies of the data they wished to reproduce.

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9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz in view of Doi. Linnartz discloses a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a signal of digitized video data and/or a signal of audio data (Abstract; see also column 2, line 26, through column 3, line 67), said reproduction apparatus comprising: a reproducing unit which reproduces the information concerning copying permission superimposed on the video data and/or audio data (Abstract; column 5, lines 41-54); and a determining unit which determines whether the medium to be reproduced is a recordable medium (column 5, lines 54-66; column 7, lines 4-13), but does not clearly and expressly disclose determining whether the medium to be reproduced is dedicated to reproduction or to recording; furthermore, Doi teaches determining whether a medium is dedicated to reproduction or recording (column 13, lines 46-55). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include in the apparatus of Linnartz a determining unit which determines whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, and to stop reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

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a.Linnartz discloses a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted and a result of the identification by the identifying unit indicating that the medium is a medium dedicated to reproduction (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 5, lines 54-66; column 6, lines 22-45).

b.Linnartz does not disclose an output unit which outputs a control signal, the control signal instructing a video signal and/or audio signal representing a reason of stoppage to be outputted. However, official notice is taken that it is well known for computers and other apparatuses to output data representing a reason why operations are not possible, and that it is well known to convey information by video signals (e.g., written words on a screen, diagrams, and other symbols) and by audio signals (e.g., spoken, recorded, or generated words, as well as buzzer sounds, etc.). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to output a control signal instructing a video signal and/or audio signal representing a reason of stoppage, for the obvious advantage of conveniently notifying users, and encouraging them to buy copies of the data they wished to reproduce.

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz in view of Doi, Tozaki et al., and Mardirossian. Linnartz discloses a reproduction apparatus for reproducing video data or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being

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generated by superimposing information concerning copying consent on a signal of digitized video data and/or a signal of audio data (Abstract; see also column 2, line 26, through column 3, line 67), said reproduction apparatus comprising: a reproducing unit which reproduces the information concerning copying consent superimposed on the video data and/or audio data (Abstract; column 5, lines 41-54); and a determining unit which determines whether the medium to be reproduced is a recordable medium (column 5, lines 54-66; column 7, lines 4-13), but does not clearly and expressly disclose determining whether the medium to be reproduced is dedicated to reproduction or to recording; furthermore, Doi teaches determining whether a medium is dedicated to reproduction or recording (column 13, lines 46-55). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include in the apparatus of Linnartz a determining unit which determines whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, and to stop reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

a. Linnartz does not disclose an error correction unit, but Tozaki et al. teach an error correction unit which conducts error correction according to an added correction code (column 14, lines 46-51; note also column 13, lines 51-57). Hence it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include an error correction unit, for the stated advantage of correcting errors.

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b.Linnartz discloses a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 6, lines 22-45), but does not disclose a destroying unit which destroys reproduced data so as to make the video data and/or audio data non-reproducible in response to information indicating that copying once was permitted and a result of the determining unit indicating that the medium is a medium dedicated to reproduction. However, Mardirossian (5,636,096) teaches destroying data to prevent unauthorized copying (Abstract; column 5, lines 12-35). (See also, for example, Park, 5,796,826, Abstract; and column 5, lines 49-57.) Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a destroying unit which destroys reproduced data so as to make the video data and/or audio data non-reproducible in response to the information reproduced by a reproducing unit indicating that copying once was permitted and a result of the determining by the determining unit indicating that the medium is a medium dedicated to reproduction, for the obvious advantages of preventing unauthorized reproduction and deterring attempts thereat. Moreover, it is held that when data is destroyed, error detection and error correction of the said data necessarily become impossible.

c.Linnartz does not disclose an output unit which outputs video data and/or audio data representing a reason why reproduction is impossible to be outputted. However, official notice is taken that it is well known for computers and other apparatuses to output data representing a reason why operations are not possible, and that it is well known to convey information by video

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data (e.g., written words on a screen, diagrams, and other symbols) and by audio (e.g., spoken, recorded, or generated words, as well as buzzer sounds, etc.). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to output video data and/or audio data representing a reason why reproduction was impossible to be outputted, for the obvious advantage of conveniently notifying users, and encouraging them to buy copies of the data they wished to reproduce.

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz as applied to claim in view of Doi. Linnartz discloses a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data and a medium identification code recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a signal of digitized video data and/or a signal of audio data (Abstract; see also column 2, line 26, through column 3, line 67), said reproduction apparatus comprising: a permission information reproduction circuit reproducing the information concerning copying consent superimposed on the video data and/or audio data (Abstract; column 5, lines 41-54); a medium identification code detection circuit detecting the medium identification code (column 5, lines 54-66); and a reproduction stopping circuit stopping reproduction in response to the information reproduced by the permission information reproduction circuit indicating that copying once was permitted (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 6, lines 22-45) and

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that the medium identification code indicates a medium dedicated to reproduction (column 5, lines 54-66). Linnartz discloses determining whether the medium to be reproduced is a recordable medium (column 5, lines 54-66; column 7, lines 4-13), but does not clearly and expressly disclose determining whether the medium to be reproduced is dedicated to reproduction or to recording; furthermore, Doi teaches determining whether the medium identification code identifies the medium as a medium dedicated to reproduction or a recording (column 13, lines 46-55). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include determining whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, for the stated advantage of limiting the reproduction of proprietary information.

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz and Doi as applied to claim 8 above. Linnartz does not disclose integrating a medium identification detecting circuit and a reproduction stopping circuit into a single semiconductor device, but official notice is taken that it is well known to integrate a multiplicity of circuits into a single semiconductor device (as witness the terms "integrated circuit" and "computer on a chip"). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to integrate these several circuits into a single semiconductor device, for the obvious advantages of simplifying chip manufacture, not needing to connect a multiplicity of chips to one another, and enhanced security, in that signals within a single chip

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cannot be as readily detected and falsified as signals between separate chips or other arrangements of circuit elements.

13. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz in view of Doi. Linnartz discloses a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a signal of digitized video data and/or a signal of audio data (Abstract; see also column 2, line 26, through column 3, line 67), said reproduction apparatus comprising: a reproduction unit for reproducing the information concerning copying consent superimposed on the video data and/or audio data (Abstract; column 5, lines 41-54); and a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 6, lines 22-45) and that the medium is a medium dedicated to reproduction (column 5, lines 54-66; column 7, lines 4-13). Linnartz does not disclose a detection unit for detecting reflectance of a disk, or a determining unit for determining whether the disk is a recordable medium or a medium dedicated to reproduction on the basis of the reflectance of the disk, but Doi teaches these (Abstract; column 13, lines 46-55). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include in the apparatus of Linnartz a detection unit for detecting the

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reflectance of a disk, and a determining unit for determining whether a medium is a recordable medium or a medium dedicated to reproduction on the basis of the reflectance of the disk, for the obvious advantage of preventing the unauthorized reproduction of proprietary data.

14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz in view of Doi. Linnartz discloses a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a signal of digitized video data and/or a signal of audio data (Abstract; see also column 2, line 26, through column 3, line 67), said reproduction apparatus comprising: a reproduction unit for reproducing the information concerning copying consent superimposed on the video data and/or audio data (Abstract; column 5, lines 41-54); an identification detection unit for detecting the medium identification code (column 5, lines 54-66; column 7, lines 4-13); and a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 6, lines 22-45) and that the medium is a medium dedicated to reproduction (column 5, lines 54-66; column 7, lines 4-13). Linnartz does not disclose a detection unit for detecting reflectance of a disk, or a determining unit for determining whether the disk is a recordable medium or a medium dedicated to reproduction on the basis of the reflectance of the disk, but Doi teaches these (Abstract;

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column 13, lines 46-55). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include in the apparatus of Linnartz a detection unit for detecting the reflectance of a disk, and a determining unit for determining whether a medium is a recordable medium or a medium dedicated to reproduction on the basis of the reflectance of the disk, and having the stopping unit stop reproduction based in part on the determining unit indicating a medium dedicated to reproduction, for the obvious advantage of preventing the unauthorized reproduction of proprietary information.

15. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz in view of Yokota et al. and of Fox. Linnartz discloses a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a signal of digitized video data and/or a signal of audio data (Abstract; see also column 2, line 26, through column 3, line 67), said reproduction apparatus comprising: a reproduction unit for reproducing the information concerning copying consent superimposed on the video data and/or audio data (Abstract; column 5, lines 41-54); and a stopping unit for stopping reproduction provided that the information reproduced by the reproduction unit indicates that copying once was permitted (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 6, lines 22-45). Linnartz does not disclose a wobble detection unit for detecting wobbled grooves existing on a disk, but Yokota et

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al. teach such a wobble detection unit (column 3, lines 43-55). Furthermore, Fox explicitly teaches preventing piracy by a system which rejects disks for copying if they lack wobbled grooves (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include in the apparatus of Linnartz a wobble detection unit for detecting wobbled grooves, and to stop reproduction if the wobble detecting unit does not detect wobbled grooves, for the stated advantage of limiting the reproduction of proprietary data.

16. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz in view of Yokota et al. and of Fox. Linnartz discloses a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a signal of digitized video data and/or a signal of audio data (Abstract; see also column 2, line 26, through column 3, line 67), said reproduction apparatus comprising: a reproduction unit for reproducing the information concerning copying consent superimposed on the video data and/or audio data (Abstract; column 5, lines 41-54); and identification unit for detecting the medium identification code (column 5, lines 54-66; column 7, lines 4-13); and a stopping unit for stopping reproduction provided that the information reproduced by the reproduction unit indicates that copying once was permitted (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 6, lines 22-45) or

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the medium identification code indicates a medium dedicated to reproduction (column 5, lines 54-66; column 7, lines 4-13). Linnartz does not disclose a wobble detection unit for detecting wobbled grooves existing on a disk, but Yokota et al. teach such a wobble detection unit (column 3, lines 43-55). Furthermore, Fox explicitly teaches preventing piracy by a system which rejects disks for copying if they lack wobbled grooves (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include in the apparatus of Linnartz a wobble detection unit for detecting wobbled grooves, and to stop reproduction if the wobble detecting unit does not detect wobbled grooves, for the stated advantage of limiting the reproduction of proprietary data.

17. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz in view of Doi. Claim 14 recites a method of doing what claim 1 recites apparatus for doing; therefore, claim 14 is rejected on the same grounds as claim 1. (Examiner does not believe the distinction between permission and consent to be of any importance in this context.)

18. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz in view of Doi, Tozaki et al., and Mardirossian. Claim 15 recites a method of doing what claim 2 recites apparatus for doing; therefore, claim 15 is rejected on the same grounds as claim 2. A slight complication is that claim 15 additionally recites "simultaneously judging error correction to be impossible," which claim 2 does not. However, if data is being destroyed altogether, as recited in

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claims 2 and 15, error correction is held to be inherently impossible, or at least pointless. One cannot correct data which does not exist.

19. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linnartz in view of Doi. Claim 16 recites a program for doing what claim 1 recites apparatus for doing; therefore, claim 16 is rejected on the same grounds as claim 1. (Examiner does not believe the distinction between permission and consent to be of any importance in this context.)

Response to Arguments

20. Applicant's arguments filed August 22, 2001 have been fully considered but they are not persuasive. Applicant describes Examiner as relying on Park to support the rejection of claims 2, 3, 5, 7, and 15, and objects that Examiner failed to include Park in the statements of rejection for these claims. Examiner responds that he did not rely upon Park in rejecting any claims, but merely mentioned Park parenthetically, "(See *also, for example*, Park, 5,796,826, Abstract; and column 5, lines 49-57.)" (emphasis added). Applicant writes, "[T]he Examiner's comments regarding Park will be disregarded until such time that the Examiner includes Park in the statement of the rejection of claims 2-3, 5, 7, and 15." Examiner responds that Applicant is, in Examiner's view, perfectly at liberty to disregard Examiner's comments regarding Park, although Examiner respectfully suggests that it might not be expedient for Applicant, should he amend

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claims in an effort to make them patentable, to disregard the existence of Park as possibly relevant prior art, which might be relied upon in future.

Applicant next analyzes the teachings of Linnartz and of Doi, and argues that there is no suggestion in either, or in the knowledge generally available to one of ordinary skill in the art, to combine Linnartz and Doi to provide an apparatus which stops reproduction in response to a result indicating that a medium is a medium dedicated to reproduction. In response to Applicant's argument that there is no suggestion to combine the references, Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Linnartz is considered to provide the motivation, since the goal of Linnartz's invention is to prevent or limit unauthorized or excessive copying, and Linnartz expressly discloses (as prior art!) that it is known to use copy bits to indicate that a medium is a "professional" medium, and not a "recordable" disc (column 1, lines 45-65). Examiner holds this to be a clear statement of motivation to be found in the principal reference itself, and in the knowledge generally available to one of ordinary skill in the art, as admitted background of the primary reference.

As regards Applicant's argument that Linnartz and Doi do not disclose or suggest a stopping unit which stops reproduction in response to the information reproduced by a

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reproducing unit indicating that copying once was permitted and a result of the determining by the determining unit indicating that the medium is a medium dedicated to reproduction.

Examiner admits that Linnartz and Doi do not expressly disclose a stopping unit which stops reproduction in response to both these kinds of information. However, Linnartz does disclose a stopping unit which stops reproduction in response to information reproduced by a reproducing unit indicating that copying once was permitted (column 3, lines 17-67; column 4, line 58, through column 5, line 2; column 6, lines 22-45), and, as noted, Linnartz discloses, in the context of copy protection, copy bits indicating whether a medium is a medium dedicated to reproduction (column 1, lines 45-65). It is difficult to conceive of the purpose of these copy bits, if copying would not be stopped in response to a determination of copy bits showing a medium to be a medium not intended as recordable.

Applicant's principal arguments having been found unpersuasive, Applicant's assertions that the other prior art of record does not supply the alleged deficiencies of Linnartz and Doi are moot, while Applicant's assertion dependent claim 9 also recites further features of the invention which are not seen to be disclosed or suggested by the prior art is unpersuasive for lack of identification of these further features, and lack of either a challenge to Examiner's taking of official notice, or an explanation of why the existence of integrated circuits, of which official notice was taken, fails to make dependent claim 9 obvious in view of the prior art relied upon in rejecting independent claim 8.

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Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Usui et al. (US 2001/0006578 A1) disclose an information signal duplication control system. Sugita et al. (US 2001/0007608 A1) disclose an information transmission method and information duplication prohibiting method. Tanaka et al. (US 2001/0011237 A1) disclose a method and apparatus for recording and reproducing information on and from a recording disc. Ogino et al. (US 6,271,887 B1) disclose a method, apparatus, and system for transmitting and receiving an image signal having superimposed information and for extracting information superimposed on an image signal.

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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23. Any inquiry concerning this communication or earlier communications from the examiner should be addressed to Nicholas D. Rosen, whose telephone number is (703) 305-0753. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.


If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached at (703) 308-1344. The fax number for this Group is (703) 308-1396.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to Nicholas.Rosen@uspto.gov.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 305-3900.


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Nicholas D. Rosen

October 5, 2001